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Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Please see the attached Reply

This communication is in response to Appellant's "STATEMENT OF RELEVANT AUTHORITY PURSUANT TO 37 C.F.R. 1.192(a)" which was submitted on 01 July of 1996.

Appellant's position that the instant rejection of claims 1 to 14, 24 to 34, 39 to 57 and 59 under 35 U.S.C. § 103 as being unpatentable over the Petkovich et al. publication in view of the Hauptmann et al. and Krust et al. publications is in conflict with the decision in In re Deuel, 94-102 (Fed. Cir. 1995). In re Deuel held that "A prior art disclosure of the amino acid sequence of a protein does not necessarily render particular DNA molecules encoding the protein obvious because the redundancy of the genetic code permits one to hypothesize an enormous number of DNA sequences coding for the protein". The instant rejection is not in conflict with that decision because it does not host a recombinant DNA to be obvious over a protein. The instant rejection is based upon the fact that part of the claimed DNA was disclosed in Figure 3c on page 447 of the Petkovich et.al., as well as the chromosomal location of the entire gene corresponding thereto and the fact that this gene was located downstream from the insertion site of the hepatitis B virus (HBV) genome in a human hepatoma and encoded a protein that was a member of the nuclear hormone receptor family. Contrary to the rejection in In re Deuel, the instant rejection is based upon a conclusion that the disclosure of a significant part of a DNA in conjunction with

a motivation to isolate a complete DNA was sufficient to render that complete DNA *prima facie* obvious to one of ordinary skill. The secondary references which have been relied upon simply show that, once given a partial DNA like the one that was described in the Petkovich et.al. publication it was nothing more than the routine practice of the art of molecular biology to isolate the complete DNA.

Appellant's arguments regarding the modification of a preexisting compound to arrive at a compound having the innate properties of a DNA of the instant invention is irrelevant to the instant rejection as explained in the Examiner's answer. Appellant did not "invent" a DNA having the disclosed sequence. This DNA is a chemical compound which is the invention of nature and which was present in every human genomic DNA library and cDNA library that has been made prior and subsequent to the making of the instant invention. A review of pages 13 and 14 of the instant specification does not describe the "making" of a cDNA of the instant invention and it is not clear from the text therein that Appellant actually "made" a cDNA. This text only described the "isolation" of a preexisting compound from a mixture of chemically related compounds referred to therein as a cDNA library. The sequence of that cDNA was an innate property of that compound and which was unchange by its isolation.

Appellant's inventive contribution had no effect on the innate properties of this preexisting compound.

The instant invention is the provision of a composition in which that preexisting compound is the only ingredient. The recitation of this sequence in the claims does not distinguish the compound contained therein from that compound as it was found in that library. It is only the recitation of "isolated and purified" which avoids a rejection of the instant claims as being anticipated by any human cDNA library of the prior art since Figure 3 of the instant application clearly shows that any human cDNA library would have contained a cDNA species having the nucleotide sequence of the claimed DNA. The instant rejection is based upon the fact that the prior art of record provided specific motivation for making Appellant's inventive contribution, i.e. for "isolating" a preexisting DNA corresponding to the entire hORF that was described in Figure 3c of Petkovich et al. and that prior art would have led an artisan to the claimed composition and no other.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm at telephone number (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM. The fax phone number for this group is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

JOHN ULM
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